

REMARKS

Initially, it is noted that the Examiner has objected to the drawings under 37 CFR § 1.83(a) because certain limitations provided for in claims 41 and 50 of the present application are not shown therein. In order to overcome the Examiner's objection, Applicant has cancelled such claims, without prejudice. In addition, Applicant has cancelled claim 51, without prejudice, as depending from now cancelled claims 50. In view of the foregoing, Applicant respectfully requests withdrawal of the Examiner's rejection to the drawings under 37 CFR § 1.83(a).

The Examiner has objected to the Specification due to certain typographical errors on pages 5-6 thereof. Applicant has amended the Specification to correct the typographical errors and withdrawal of the Examiner's objection to the Specification is respectfully requested. In addition, the Examiner has objected to claims 34-35, 38, 41, 43-45 and 53 due to certain informalities. Applicant has amended such claims as suggested by the Examiner and withdrawal of the Examiner's objection to such claims is respectfully requested.

The Examiner has rejected claims 50 and 55 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As previously noted, Applicant has cancelled claim 50. In addition, applicant has amended claim 55 to eliminate the indefinite phrase, "or the like" therefrom per the Examiner's instructions. Withdrawal of the Examiner's rejection to claim 55 under 35 USC §112, second paragraph, is respectfully requested solicited.

The Examiner has rejected claims 34-35, 38, 46 and 50 under 35 USC §102(b) as being anticipated by Hoffmann, Sr. (US Patent No. 5,620,768). In addition, claims 34-

40, 42, 43, 45 and 47-51 have been rejected under 35 USC 103(a) as being unpatentable over Shickel (US Patent No. 4,902,550) in view of Byrd et al. (US Patent No. 6,123,172) and claim 52 has been rejected under 35 USC 103(a) as being unpatentable over the Shickel '550 patent and the Byrd et al., '172 patent in view of Beaupre (US Patent No. 4,310,587). Claim 41 has been rejected under 35 USC 103(a) as being unpatentable over the Hoffmann, Sr. '768 patent in view of Hoffmann, Sr. (US Patent No. 4,135,017) and claims 44, 53 and 57-58 have been rejected under 35 USC 103(a) as being unpatentable over the Hoffmann, Sr. '768 patent. Finally, claims 54-56 have been rejected under 35 USC 103(a) as being unpatentable over the Hoffmann, Sr. '768 patent in view of Swallow (US Patent No. 5,820,958). As hereinafter described, Applicant has amended the pending claims to more particularly define the invention for which protection is sought. Reconsideration of the Examiner's rejections is respectfully requested in view of the following comments.

Claim 34 defines a multi-layer covering adapted to cover an object surface, such as a surface of a building or other solid object, and to support an applied coating. The multi-layer covering includes a fabric layer defining an outer surface of the multi-layer covering. A non-fabric backing layer is bonded to an inner surface of the fabric layer and is coextensive with the fabric layer. An adhesive is disposed on an inner surface of the backing layer and a removable protective layer covers the adhesive on the inner surface of the backing layer. The protective layer is removable to allow the multi-layer covering to be adhered to and cover the object surface, such that the outer surface of the fabric layer provides a smooth surface for supporting the applied coating. The fabric layer is sufficiently porous to allow the applied coating to penetrate to the backing layer and the backing layer has a series of through holes adapted to allow the applied coating to penetrate through the backing layer to the object surface. As hereinafter described, nothing in the cited references shows or suggests a multi-layer covering adapted to cover

an object surface that includes a non-fabric backing layer that is “coextensive with the fabric layer.”

Hoffmann Sr. (US 5,620,768) discloses a multi-layer repair patch that is adapted to be used to repair individual holes and cracks in surfaces such as drywall or automotive body panels. One or more patches are used to cover an individual hole or crack and the surface area immediately surrounding the hole or crack. However, applying these patches to individual cracks and holes causes undesirable undulations across the surface. Reinforcing individual cracks or holes can also induce further cracking in other areas that are not covered, due to differing stress profiles across the surface.

In contrast, the present invention is designed to *prevent* cracking in a surface coating, as well as, cover up existing cracks rather than merely to *repair* individual cracks and holes. By applying the multi-layer covering of the present invention to an entire surface before coating the surface, future cracking of the surface and the surface coating can be avoided. The multi-layer covering acts to absorb stresses applied to the surface by dissipating the stress across the entire area of the multi-layer covering. Further, should any cracks occur in the underlying surface, the multi-layer covering helps prevent corresponding cracks in the surface coating by stretching across the cracks in the underlying surface.

As heretofore described, claim 34 defines that the multi-layer covering including “a non-fabric backing layer bonded to an inner surface of the fabric layer and coextensive with the fabric layer” which allows the multi-layer covering to be applied to the surface in a manner similar to wallpaper. One of the primary features of Hoffmann Sr. patch is the overlapping of the inner and outer mesh means around the perimeter of the sheet means. This teaches away from the present invention as defined in claim 34, which defines that the non-fabric backing layer is “coextensive with the fabric layer.” The only non-fabric layer of the Hoffmann, Sr. patch is the sheet means (12). As the inner mesh

means (11) of the Hoffmann, Sr. patch is a fabric layer, it cannot be considered to form part of the backing layer as defined in claim 34 of the present application. It can be appreciated that the coextensive nature of the multi-layer covering of the present invention allows for the resulting covered surface to be smooth and for the stress profile across the surface to be more uniform. This arrangement, in turn, results in less cracking to the surface itself and to the surface coating as well.

Further, it would not be obvious to a person skilled in the art to modify the patch of the Hoffmann, Sr. '768 patent to arrive at the present invention as defined in claim 34, since the '768 patent teaches away from the present invention. More specifically, the Hoffmann, Sr. '768 patent teaches that "[s]ubstantial outer margins 33, 34 of the inner mesh means 11 and outer mesh means 13 respectively extend outward beyond the outer periphery defined by the sheet means 12." (Col 6, Ln 18-21) Because it is the sheet means that provides most of the strength to the patch, this creates areas of weakness around the periphery of the patch and means that the stress profile across the surface will vary greatly around the patch. Further, if multiple patches of Hoffmann Sr. were used to cover long multi-directional cracks, a series of overlapping patches would be required, resulting in varying thicknesses of patch material in different areas. This would lead to an uneven coating thickness and stress concentrations in areas with very thin or no patch covering, resulting in further cracking over time.

In contrast, because both the fabric layer and the backing layer are coextensive, the multi-layer covering of the present invention can be applied in a manner similar to wallpaper to cover an entire surface, resulting in a smooth outer surface and a more uniform stress profile across the surface. As defined in claim 34, "the outer surface of the multi-layer covering provides a smooth outer surface for supporting the applied coating". Further, as well as being able to be applied during renovation of a damaged surface, the present invention is designed to be applied to a newly constructed building surface,

before a coating is applied to the surface. In this way, the multi-layer covering of the present invention seeks to prevent cracks from forming, rather than merely covering up existing cracks.

Accordingly, the applicant submits that the present invention as defined in amended claim 34 at least is both novel and unobvious in light of Hoffmann Sr '768 patent. As hereinafter described, neither the Schickel '550 patent nor the Byrd et al., '172 patent can cure the deficiencies of the '768 patent.

Schickel defines a laminated insulating material that performs a completely different function to the present invention. The Schickel material is adapted to be placed adjacent to a ceiling or wall panel in a ceiling or wall cavity to absorb thermal energy escaping from an insulated space. It is noted that the reference numbers identified by the Examiner corresponding to the backing layer (11, 12) and the through holes (19, 23) are not consistent with the reference numbers in Schickel. These appear to be the relevant reference numbers in respect of Hoffmann, Sr. As a consequence, Applicant has assumed that the Examiner has compared backing layer of independent claim 34 with the facing 40 and the through holes of claim 34 with the perforations 38'.

In contrast to the laminated insulating material disclosed in the Schickel '550 patent, the present invention as claimed is a surface covering adapted to cover a surface and support an outer coating. The problem addressed by the present invention is to provide a smooth surface for supporting a coating over a rough underlying surface and to prevent cracking in the coating as the underlying surface moves or cracks. The Schickel material is not intended (and would not be able) to support any type of coating as it is an internal insulation material. The outer laminate of the Schickel material is preferably formed from fibrous glass, mineral wool, slag wool or rock wool (Col 4, Ln 3-6). None of these materials is adapted to support a coating such as paint or rendering on the surface of building. In addition, there is nothing in the disclosure of Schickel that would lead a

skilled person to apply the insulating material of Schickel to the exposed surface of a wall in order to use the insulating material to support a coating of paint or rendering. Even if the insulating material of Schickel was applied to an outer surface of a building, it would not provide a smooth surface that was adapted to support a coating.

The Byrd et al. patent discloses a flexible, adhesively attachable, self-sealing, thermal and acoustical insulating shield with a needled, flexible, fibrous batt having an insulating layer of insulating fibers disposed between opposite binding layers of binding fibers. Binding fibers of each binding layer are needledly disposed through the insulating layer and an opposite binding layer to provide tufts of binding fibers protruding from the opposite binding layer so as to form a tufted upper surface and a tufted lower surface of the batt. A flexible adhesive is disposed and adhered substantially over the upper surface and, preferably, over lower surface of the batt such that the tufts on the upper and lower surfaces are secured to the surfaces by the adhesive. A flexible, protective foil is adjacent to, and preferably permanently adhered by the adhesive to, the lower surface of the batt. The protective foil has edge portions which extend beyond edges of the fibrous batt and the edge portions have a flexible adhesive disposed and adhered substantially over upper edge surfaces of the edge portions.

Clearly, there is no teaching or suggesting in Byrd et al. patent that would lead a skilled person to apply the insulating material of Schickel to a building surface in order to support a coating. In fact, both documents teach away from the present invention as both documents relate to insulating materials adapted to be arranged in internal cavities of buildings, rather than to cover the outer surfaces of walls, ceilings and floors. Further, unlike like the multi-layer coating of claim 34, the “backing layer” or protective foil in the Byrd et al. patent extends beyond edges of the fibrous batt. This is in contrast to the multi-layer covering of claim 34 wherein the covering includes a non-fabric backing layer that is “coextensive with the fabric layer.”

In view of the foregoing, it is believed that independent claim 34 defines over the cited references and is in proper form for allowance. Claims 35-40 42-49 and 52 depend either directly or indirectly from independent claim 34 and further define a multi-layer covering not shown or suggested in the prior art. It is believed that claims 35-40 42-49 and 52 are allowable as depending from an allowable base claim and in view of the subject matter of each claim.

Referring to claim 53, a method is provided of treating an object surface such as a wall, ceiling, roof, or floor. The method includes the steps of providing the multi-layer covering, as heretofore described with respect to claim 34, and removing the removable protective layer of the multi-layer covering. The multi-layer covering is applied to the object surface using the adhesive to retain the multi-layer covering in position. The multi-layer covering is applied so that so that substantially all of the object surface is covered by both the fabric layer and the backing layer and so that the outer surface of the fabric layer provides a smooth surface. One or more coatings is applied to the smooth outer surface of the multi-layer covering, such that the applied coating penetrates through the fabric layer and through the holes of the backing layer to the object surface.

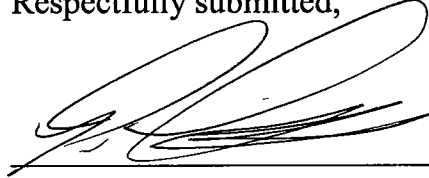
As heretofore described with respect to independent claim 34, nothing in the Hoffmann, Sr. '768 patent shows or suggests a multi-layer covering in accordance with the present invention. Further, as previously noted, by applying the multi-layer covering of the present invention to an entire surface before coating the surface, future cracking of the surface and the surface coating can be avoided. This step is entirely absent from the cited reference. Consequently, it is believed that independent claim 53 defines over the cited references and is in proper form for allowance. Claims 54-58 depend either directly or indirectly from independent claim 53 and further define a methodology not shown or

suggested in the prior art. It is believed that claims 54-58 are allowable as depending from an allowable base claim and in view of the subject matter of each claim.

Applicant believes that the present application with claims 34-40 42-49 and 52-58 is in proper form for allowance and such action is earnestly solicited. Applicant believes that no fees are due in connection with this Amendment. However, if Examiner considers any fees due in conjunction with this or any future communication, authorization is given to charge payment of such fees or credit any overpayment to Deposit Account No. 50-1170.

Should the Examiner have any questions or comments regarding this Response which would expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,



Peter C. Stomma, Reg. No. 36,020

Dated: 6/22/09

Boyle Fredrickson, S.C.
840 North Plankinton Avenue
Milwaukee, WI 53203
(414) 225-9755
Customer No.: 23598